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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/142,452	01/19/1999	OSKAR K. WACK	19866.PCT/FA	2215

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EXAMINER

MARKOFF, ALEXANDER

ART UNIT PAPER NUMBER

1746

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/142,452

Applicant(s)

WACK ET AL.

Examiner

Alexander Markoff

Art Unit

1746

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 70-75, 77-89 and 91-125 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 70-75, 77-89 and 91-125 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 06/01/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/01/04 has been entered.

Information Disclosure Statement

2. The IDS filed on 6/1/04 has been considered. It is noted the document that was filed is not a JP patent document. What was filed is a partial translation of the document. The appropriate correction was made on the PTO 1449.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 70-75, 77-89 and 91-125 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for some of the compositions, does not reasonably provide enablement for all the claimed concentration range. The specification does not enable any person skilled in the art to which it

Art Unit: 1746

pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

The claims require an oil-in-water emulsion. US Patent 5,597,792 teaches that for the most of water concentrations the claimed mixture of dipropyleneglycol mono-n-propyl ether and water would form water-in-oil emulsion. It appears that some additional concentration limitations and/or constituents limitations and/or conditions are required to form an oil-in-water emulsion and that the claims are not enabled for the entire claimed scope.

5. Claims 70-74, 77-88 and 91-125 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure, which is not enabling. The original disclosure requires the composition to be an azeotropic preparation. This is critical or essential to the practice of the invention, but not included in the claim(s). The claims lacking recitation of the "azeotropic preparation" are not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

The original disclosure clearly requires the method of the invention to utilize the composition, which is "azeotropic preparation". The original disclosure is not enabled for the claims lacking recitation of the limitation "azeotropic preparation".

6. Claims 118-125 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

had possession of the claimed invention. The claims require the organic-rich phase being fully dissolved phase in the absence of the application of agitation or ultrasound" this is not supported by the original disclosure. The original disclosure fails to teach the organic-rich phase as being a fully dissolved phase. This teaching is presented neither for the case of the presence of the application of agitation or ultrasound, nor for the case wherein such application is absent.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. Claims 70-96 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims use the term "optically cloudy" this is a relative term and the meaning of this term is not defined with respect to the emulsions. The specification does not provide antecedent basis for the term; thereby the scope of the term is not definite.

Specification

9. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification fails to provide support for the limitation claimed as "optically cloudy".

Response to Amendment

10. The amendment filed 6/01/04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The newly submitted claims 118-125 require the organic-rich phase being fully dissolved phase in the absence of the application of agitation or ultrasound. This is not supported by the original disclosure. The original disclosure fails to teach the organic-rich phase as being a fully dissolved phase. This teaching is presented neither for the case of the presence of the application of agitation or ultrasound, nor for the case wherein such application is absent.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

Art Unit: 1746

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 70-73, 75, 77-86, and 88, 89 and 91-112, 114-123 and 125 are rejected under 35 U.S.C. 102(e) as being anticipated by Klier et al (US Patent No 5,597,792).

Klier et al teach the use of emulsion of the claimed composition for cleaning. Klier et al teaches that at least for some time, some concentration, some application steps and/or temperatures the emulsion is oil-in-water emulsion. Klier et al teach the claimed dipropyleneglycol mono-n- propyl ether as a preferred solvent. See entire document, especially columns 3-5 and column 8, line 62 – column 10, line 27. It is noted that Klier et al recommend the use of water-in-oil emulsion, but the disclosure of the document is not limited to the preferred embodiments.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

Art Unit: 1746

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. Claims 74 and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klier et al.

Klier et al do not specify the cleaning temperature. However, temperature of a cleaning process is a result effective variable. It would have been obvious to an ordinary artisan at the time the invention was made to find an optimum cleaning temperatures for the specific application by routine experimentation in order to enhance cleaning.

Response to Arguments

17. Applicant's arguments filed 6/1/04 have been fully considered but they are not persuasive.

The applicants filed Arguments in the response to the last Office action. The applicants analyze the teaching of the applied document and rely on the fact that the document shows a complex nature to argue that the emulsions and microemulsions of the prior art are different compare with the ones, which are utilized by the claimed method. The arguments are not found persuasive:

First, the arguments are based on incorrect interpretation and misquotation of the document. Such, the applicants state on page 19 of their response that the applied document teaches at col. 2, lines 7-9 that emulsions are prepared by adding water to microemulsions. No such teaching is presented at the cited part of the document. The applicants further state (page 20 of the response) that according to them, when the document teaches emulsions a skilled person understands that sufficient water is added to the microemulsions. This conclusion contradicts to the teaching of the reference. See at least Examples 1 and 17-19, wherein the process of preparing of the emulsions is disclosed. Moreover, the applicant's arguments contradict to the teaching of the document, which states that adding of water provides water continuous microemulsion. See at least column 8, line 63- column 9, line 11.

Second, the fact that some of the disclosed emulsions and microemulsions of Klier et al have a complex nature does not change the fact that the document discloses the emulsions and microemulsions with continuous water phase. The teaching regarding this is presented at least at column 8, line 63- column 9, line 11 and column 9, lines 48-57. This part of the document was cited in the previous Office action. The applicants failed to comment on this teaching.

Third, the applicants based most of their arguments on their assumptions regarding the structure of the emulsions of Klier et al and how the emulsions and microemulsions of Klier et al would appear. These arguments are not persuasive because the applied document teaches a method comprising the same steps as the claimed method, and utilizing the compositions having the same constituents in the

same proportions as the claimed ones, and teaches at least some of the compositions being water continuous. Whether or not the applicants are correct with their assumptions regarding some of the embodiments disclosed by the prior art is not relevant because at least some of the embodiments are disclosed as water-continuous.

Fourth, it is noted that in contrast to the applicant's arguments Klier et al teach that adding of water to oil-continuous microemulsions would not lead to water/microemulsion system. No such teaching has been found in the document.

Fifth, in contrast to the applicant's assumption that the emulsions of Klier et al are water/microemulsion system contradicts to the teaching of the document, which teaches either oil-continuous or water-continuous emulsions. See at least column 2, lines 30-40 and column 9, lines 48-57. The fact that the emulsions left at some conditions for some time may change their structure, does not support the applicant's assumption.

Sixth, the original disclosure of the instant application is silent regarding what is the organic phase in the compositions utilized by the method of the invention. The applicant's arguments regarding the alleged differences between the organic phase in Klier et al and the method of the invention are not supported.

The examiner would like to note that the terms "oil-in-water" and "water-in-oil" are conventionally used by the prior art to reference "organic-in-water" and "water-in-organic" emulsions. These terms are used as a conventional classification of emulsions. See at least McGraw-Hill Encyclopedia and Klier et al. Thereby the terms were used by the examiner. It is not clear why the applicants argue the use of the term.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Markoff whose telephone number is 571-272-1304. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alexander Markoff
Primary Examiner
Art Unit 1746

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**ALEXANDER MARKOFF
PRIMARY EXAMINER**